

REMARKS

Claims 1-15 are all the claims pending in the application. Claims 12-15 have been added.

As a preliminary matter, at page 2, paragraph 1, the Examiner includes a section entitled “Summary of the Claims”. While the Examiner’s “Summary of the Claims” generally discusses the claims, the words in each particular claim, as interpreted in light of the specification and prosecution history, will control each actual claim’s interpretation in any issued patent.

Applicants have amended Claims 1-11 to reflect process claims based on support in the specification, e.g. from the Examples at pages 19-22, and the product claims, as originally filed. No new matter has been added.

Additionally, a new dependent claim wherein the conductive layer has a thickness of from 1×10^{-4} to 0.007 μm has been added as Claim 12. Support may be found, e.g., in Claim 3, which discloses the lower range thickness point of 1×10^{-4} and in Example 1 on page 19 which discloses the upper range thickness point of 0.007 μm . Such values provide support for “the conductive layer has a thickness of from 1×10^{-4} to 0.007 μm .” No new matter has been added.

See MPEP § 2163.05.III.

Finally, dependent claim 13 has been added based on support at page 15, lines 10-11 of the specification, as originally filed, and dependent claims 14 and 15 have been added based on the original disclosure of original claims 1 and 11. No new matter has been added.

Entry of the Amendment along with reconsideration and review on the merits are respectfully requested.

Claim Rejections - 35 USC § 102

At pages 2-3 of the Office Action, Claims 1-3, 5-8, and 10-11 stand rejected under 35 U.S.C. 102(b) as being anticipated by Dai Nippon (EP 0836936 A1).

The Examiner states that Dai Nippon discloses a laminated structure having a heat sealant layer and an antistatic layer, which may be adhered to a container for electric devices (abstract; p. 2 lines 5-9). A preferred embodiment teaches a laminate comprising a base layer, an adhesive layer, an intermediate layer, a heat sealant layer, and an antistatic layer, in order (p. 3 lines 28-40). The Examiner believes that the antistatic layer of Dai Nippon is deposited on the heat sealant layer and contains a semiconductor as a principal component, where the antistatic layer can be as thin as 0.01 μm (p. 11 lines 27-35) and has a surface resistivity of 10^5 - $10^{12} \Omega/\square$ (p. 17 lines 34-35).

Applicants' Comments

Applicants respectfully traverse the Examiner's rejection for the following reasons.

Applicants' independent claims 1 and 11 differ from the disclosure of Dai Nippon. The present invention claims a process for making a cover tape comprising forming a conductive layer by deposition. Dai Nippon indicates that the antistatic layer is formed by an extrusion coating process, a melt extrusion coating process, a calendar coating process, a roll coating process or a spraying process (page 11, lines 32-34). Applicants respectfully submit that Dai Nippon does not teach or disclose a method comprising forming a conductive layer by deposition as is claimed in the present invention in independent claims 1 and 11.

Accordingly, since Applicants' invention defines a method which is not anticipated by or obvious from the teachings of Dai Nippon, Applicants respectfully request reconsideration and withdrawal of the rejection under 35 U.S.C. § 102.

Claim Rejections - 35 USC § 103

Claim 9 stands rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Dai Nippon.

The Examiner concedes that that Dai Nippon fails to mention the frictional electrification voltage properties of the adhesive layer side of the cover tape. However, it is the Examiner's position that it would have been *prima facie* obvious to form a cover tape having a frictional electrification voltage of less than 3,000 V to further optimize antistatic properties of the film.

Claim 4 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Dai Nippon in view of Encyclopedia of Polymer Science and Engineering.

The Examiner applies Dai Nippon, which notes the use of several pressure sensitive adhesive (PSA) materials but which fails to mention the inclusion of a base polymer and a tackifier in specific amounts. The Examiner asserts that the Encyclopedia of Polymer Science and Engineering teaches that all rubber-based adhesives require tackifiers to impart stickiness (p. 347). Since Dai Nippon allegedly suggests the use of rubber-and acrylic-based PSAs, it is the Examiner's position that it would have been *prima facie* obvious to include a tackifier in the base resins in any amount necessary to optimize the tack of the adhesive.

Applicants' Comments

The Applicants respectfully traverse the Examiner's rejection.

Amendment Under 37 C.F.R. § 1.111
U.S. Appln. No. 09/892,859

Applicants' Claims 4 and 9 are patentable at least by the reasons of the arguments presented in traversal of independent Claim 1 from which Claims 4 and 9 depend upon, and the amendment to Claims 1-11, Applicants respectfully request reconsideration and withdrawal of the 35 U.S.C. § 103 rejection of Claims 4 and 9 by the Examiner.

Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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APPENDIX
VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE CLAIMS:

The claims are amended as follows:

1. (Amended) A method for producing a cover tape for the electronic-part conveyance, [which comprises at least four laminated layers of] said cover tape comprising:
 - a substrate;
 - at least one layer of a base coating layer and an intermediate layer, provided on the substrate;
 - an adhesive layer, provided on [the] said at least one layer of the base coating layer and the intermediate layer; and
 - a conductive layer formed on at least one of the rear surface of the substrate and the front surface of the adhesive layer [by deposition],
said method comprising forming said conductive layer on at least one of the rear surface of the substrate and the front surface of the adhesive layer by deposition.

2. (Amended) The method for producing a cover tape for the electronic-part conveyance according to claim 1, wherein the conductive layer comprises at least one of Al, Cu, Ag, Ni, Ti, Fe, Cr, Zr, Ta, Zn, and an alloy containing at least one of Al, Cu, Ag, Ni, Ti, Fe, Cr, Zr, Ta and Zn.

3. (Amended) The method for producing a cover tape for the electronic-part conveyance according to claim 1, wherein the conductive layer has a thickness of 1×10^{-4} to 0.02 μm .

4. (Amended) The method for producing a cover tape for the electronic-part conveyance according to claim 1, wherein the adhesive layer comprises 100 parts by weight of a base polymer and 2 to 100 parts by weight of a tackifier resin, and the adhesive layer has a thickness of 2 to 90 μm .

5. (Amended) The method for producing a cover tape for the electronic-part conveyance according to claim 1, wherein the base coating layer comprises at least one of a urethane adhesive and an electrostatic induction preventing adhesive.

6. (Amended) The method for producing a cover tape for the electronic-part conveyance according to claim 1, wherein the intermediate layer comprises a polyolefin based resin.

7. (Amended) The method for producing a cover tape for the electronic-part conveyance according to claim 1, wherein both surfaces of the cover tape have a surface resistivity of 10^2 to $10^{13} \Omega/\square$.

8. (Amended) The method for producing a cover tape for the electronic-part conveyance according to claim 1, [which] wherein the cover tape has a light transmittance of 60% or more.

9. (Amended) The method for producing a cover tape for the electronic-part conveyance according to claim 1, [which] wherein the cover tape has a frictional electrification voltage of 3,000 V or less at the adhesive layer side surface.

10. (Amended) The method for producing a cover tape for the electronic-part conveyance according to claim 1, wherein the substrate has a melting point of 90°C or more.

11. (Amended) A method for producing an [An] electric-part-conveying member, said electric-part-conveying member comprising:

an electronic-part-storage member for storing an electronic part; and

a cover tape [for] covering the electronic-part-storage member,

wherein the cover tape comprises at least four laminated layers of:

a substrate;

at least one layer of a base coating layer and an intermediate layer, provided on the substrate;

an adhesive layer, provided on [the] said at least one layer of the base coating layer and the intermediate layer; and

a conductive layer formed on at least one of the rear surface of the substrate and the front surface of the adhesive layer by deposition,

said method comprising forming said conductive layer on at least one side of the rear surface of the substrate and the front surface of the adhesive layer by deposition.

Amendment Under 37 C.F.R. § 1.111
U.S. Appln. No. 09/892,859

Claims 12-15 are added as new claims.